



Attorney Docket No. 30014200-1080

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: )  
Paul J. RANK et al. ) Group Art Unit: 2176  
Application No.: 09/774,354 ) Examiner: Maikhanh Nguyen  
Filed: January 30, 2001 )  
For: METHOD AND APPARATUS FOR )  
FORMULA EVALUATION IN )  
SPREADSHEETS ON SMALL DEVICES )

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program introduced in the Official Gazette (July 12, 2005), Applicants respectfully request a pre-appeal brief review. Applicants request a review of the final rejection in the above-identified application. No amendments are being filed with this request. A Notice of Appeal is submitted herewith.

**I. STATUS OF CLAIMS**

Claims 1-18 are pending in the above-identified application. Claims 1-18 were rejected in the Final Office Action dated November 23, 2005.

**II. STATUS OF AMENDMENTS**

A Response After Final was filed on February 23, 2006, wherein the claim rejections were traversed. An Advisory Action was mailed March 13, 2006, stating that the Response After Final had been considered but did not place the application in condition for allowance.

**III. ISSUES**

The issues to be reviewed are whether claims 1-4 and 10-13 are properly rejected under 35 U.S.C. § 103(a) as unpatentable over *Horie* et al. (U.S. Patent 6,487,597, hereinafter “*Horie*”) in view of *Schlafly* (U.S. Patent 5,471,612), and whether claims 5-9 and 14-18 are properly rejected under 35 U.S.C. §103(a) as being unpatentable over *Horie* in view of *Schlafly*, and further in view of *Pajokowski* et al. (U.S. Patent 6,718,425).

**IV. ARGUMENT**

Applicants contend that there is no motivation to combine the cited art in such a way that renders the present claims unpatentable, and that the Examiner has used impermissible hindsight in asserting a motivation to combine. Applicants further contend that the cited art, alone or in combination, fails to teach or suggest every limitation of every claim. Thus, the Examiner has omitted one or more essential elements needed for a *prima facie* rejection, and the rejections should be withdrawn.

A. There Is No Motivation To Combine the Cited References

Applicants respectfully submit there is no motivation to combine *Horie* and *Schlafly* as the Examiner has proposed to modify the references. “In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification.” *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). *Horie* in no way addresses the evaluation of formulas, and *Schlafly* in no way discusses transferring spreadsheet files to a device. Thus, there is no motivation to combine the references found within the references themselves, as one of ordinary skill in the art with the references before him would not be sufficiently enabled to combine the references as proposed by the Examiner.

Moreover, motivation would not be found in the knowledge of one of ordinary skill in the art, as evidenced by the long-felt need for methods and systems consistent with the present invention. See page 8, ll. 6-14 of the patent application. Neither *Horie* nor *Schlafly* addresses the nature of a problem solved by embodiments consistent with the present invention, namely the reduction of memory required by a spreadsheet file when transferred to a device such as a PDA. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Thus, one of ordinary skill in the art would not be motivated to modify *Horie* with *Schlafly* as proposed by the Examiner.

Still further, the Examiner contends that the motivation to combine is found in the increased speed of transmission of the spreadsheet from the personal computer to the PDA. This contention is illogical, however, as the evaluation of formulas during conversion and

transmission would require more computation and add more data to the file being transmitted, thus slowing the speed of transmission. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” MPEP 2143.01 (Emphasis original), *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). *Horie* fails to provide the requisite desirability for the proposed modification.

B. The Combined References Fail To Teach Every Limitation of Every Claim

Applicants have argued that the combination of *Horie* and *Schlafly* fails to teach or suggest “converting said spreadsheet file to a second format wherein said converting further comprises evaluating one or more formulas associated with said spreadsheet file **while** converting said spreadsheet file to said second format” (emphasis added). In response, the Examiner has contended that the combination of *Horie* and *Schlafly* meets the limitations of claim 1, without citing to any portion of *Horie* or *Schlafly* that teaches or suggests evaluating formulas **while** converting a spreadsheet file. The combined references must teach or suggest every limitation of the claims. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). The combined references fail to teach the contemporaneous evaluation of formulas and conversion of a spreadsheet file, as required by the word “while” in the claim. Moreover, it would not have been obvious to perform these acts contemporaneously to solve the problem at hand, as evidenced, for example, by the long-felt need described in the patent application. See page 8, ll. 6-14 of the patent application.

Applicants reiterated this traversal in the Response filed February 23, 2006. However, the Examiner still failed to answer the substance of the traversal in the Advisory Action. The Examiner has repeatedly failed to establish that the combination of *Horie* or *Schlafly* teaches or suggests “converting said spreadsheet file to a second format wherein said converting further comprises evaluating one or more formulas associated with said spreadsheet file **while** converting said spreadsheet file to said second format” (emphasis added). Accordingly, the combination of *Horie* and *Schlafly* fails to teach or suggest every limitation of the claims, and *prima facie* obviousness has not been established.

**IV. CONCLUSION**

Applicant submits that all claims are allowable over the cited prior art and respectfully request early and favorable notification to that effect.

Respectfully submitted,

  
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